

REMARKS

This Reply is in response to the Office Action mailed on March 2, 2007 in which claims 1, 2, 4-12 and 14-23 were rejected. With this response, claims 1, 10, 11 and 12 are amended and claims 24 and 25 are added. Claims 1-2, 4-12 and 14-25 are presented for reconsideration and allowance.

I. Rejection of Claims 10 and 12 under 35 USC 102(e) Based upon  
Goodman

Section 1 of the Office Action rejected Claims 10 and 12 under 35 USC 102(e) as being anticipated by Goodman et al. US Patent 6,757,071. Claims 10 and 12, as amended, overcome rejection based upon Goodman.

In response to Applicants' previous response with regard to the earlier rejection of claim 10, the Examiner noted that "determining if resolution is optimized for transparency printing" is not claimed. In response, claim 10 is amended to now recite "determining whether the printing resolution is optimized for transparency printing." The system further includes means for alerting a user if the printing resolution is not optimized for transparency printing.

Goodman fails to disclose or suggest a system for optimizing transparency printing which includes: (1) means for determining whether printing resolution is optimized for transparency printing by analyzing the printing resolution to be used to print the document and (2) means for alerting a user if the printing resolution is not optimized for transparency printing. In contrast, the only factors that Goodman appears to analyze are color content and coverage content of the document to be printed. (See column 4, lines 19-25). Nowhere does Goodman disclose analyzing the printing resolution to determine whether document formatting is optimized for transparency printing.

In response to such previous points raised, the Office Action contends that:

the enhancement of image resolution (performed in Column 4, lines 1-4) is an analysis of printing resolution. Finding resolution to be lacking and subsequently enhancing it is an analysis under any well-known definition of the word.

(Emphasis added) (Office Action dated September 7, 2006, pg. 3).

However, this reliance upon Goodman to reject claim 10 is incorrect for at least three reasons. First, nowhere does this portion of Goodman disclose that a determination or "finding" is made as to whether "resolution is lacking". Although it may be true that a determination of whether resolution is lacking would constitute an analysis under any well-known definition of the word, Goodman does not make this finding.

Second, claim 10, as amended, requires more than just an analysis of printing resolution. Claim 10 specifically recites that the analysis of printing resolution to be used to print the document is to determine whether the printing resolution is optimized for transparency printing. Nowhere does Column 4, lines 1-4 recite that any alleged analysis is done for the purpose of determining whether the document formatting is optimized for transparency printing. Rather, the recited "enhancement function" which includes image resolution on banded objects appears to be automatically performed regardless of the type of media being printed upon.

Third, Claim 10 additionally recites means for alerting a user if the printing resolution is not optimized for transparency printing. In the context of claim 10, this means that the user is alerted if the analyze printing resolution is not optimized for transparency printing. As noted above, the "enhancement function" performed by Goodman appears to be automatic. Nowhere does this cited portion of Goodman disclose that a user is alerted if printing resolution is not optimized for transparency printing. Accordingly, the rejection of claim 10 should be withdrawn. Claim 12 depends from claim 10 and overcome the rejection for the same reasons.

B. Claim 12

Claim 12 depends from claim 10. Claim 12, as amended, further recites that to the means for analyzing the document comprises means for analyzing colors used to create the document.

Claim 12 recites of the system further includes means for determining whether the font sizes are optimized for transparency printing.

Goodman fails to disclose a system wherein both printing resolution and font sizes are analyzed to determine whether both printing resolution and font sizes are optimized for transparency printing. Accordingly, claim 12 overcomes the rejection for this additional reason.

II. Rejection of Claims 1, 2, 4-9 and 11 under 35 USC 103(a) Based upon Goodman and Torpey

A. Claim 1

In response to Applicants' previous response with regard to the rejection of claim 1, the Examiner noted that "analyzing font sizes **so as to determine** whether formatting of a document is optimized for transparency printing" is not claimed. In response, claim 1 is amended to now specifically recite "analyzing font sizes **so as to determine** whether formatting of a document is optimized for transparency printing."

Neither Goodman nor Torpey, alone or in combination, disclose or suggest a method for optimizing transparency printing which includes analyzing font sizes so as to determine whether formatting of a document is optimized for transparency printing. As acknowledged by Section 7 of the Office Action dated March 2, 2007, Goodman fails to disclose the step of analyzing the document comprising analyzing font sizes used in the document. As a result, the Office Action attempted to additionally rely upon Torpey by pointing to column 16, line 61-column 17, line 28 of Torpey and asserts that Torpey discloses the step of analyzing the document comprising analyzing font sizes.

However, Torpey does not disclose analyzing font sizes so as to determine whether formatting of a document is optimized for transparency printing. In contrast, Torpey merely discloses a method by which processes reducing inter-color bleeding (i.e., adjusting borders at black/color interfaces), under-printing and maintaining edge quality (i.e., adjusting borders that

printed/non-printed interfaces) can be applied on an object oriented basis (see column 16, line 15-19 of Torpey). That portion of Torpey cited by the Office Action merely indicates that one of the classes of objects comprises text or objects having a certain font size threshold. In other words, if a certain object has a certain font size, a particular process for reducing inter-color bleeding, under printing and/or maintaining edge quality is applied. Like Goodman, Torpey discloses nothing about analyzing font size to determine whether the formatted font size is appropriate or optimized for transparency printing.

Moreover, even assuming, arguendo, that it would be obvious to modify Goodman based upon Torpey, the resulting hypothetical combination would not result in the analysis of font size to determine whether formatting of a document is optimized for transparency printing. In contrast, at most, the hypothetical combination would only analyze font size to determine which of the pixel management processes described by Torpey should be used to reduce inter-color bleeding, under-printing and to maintain edge quality. Neither Goodman nor Torpey appear to even recognize that to optimize transparency printing, the formatted font size should be analyzed. The only such teaching is found in Applicants' own disclosure. The Office Action's attempt to morph Goodman and Torpey into this claimed feature appears to be impermissibly using Applicants' own disclosure as a blueprint.

In response to such previous points, the Office Action asserts that:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Goodman by Torpey to analyze and font sizes. The motivation for doing so would have been for "analysis of print quality" (Column 17, line 13).

(Office Action dated March 2, 2007, pg. 5).

However, as noted above, even assuming, arguendo, that would be obvious to modify Goodman based upon Torpey, the resulting hypothetical combination would still fail to disclose analyzing font sizes **so as to determine** whether formatting of a document is optimized for

transparency printing. Accordingly, claim 1, as amended, overcomes the rejection based on Goodman and Torpey. Claims 2 and 4-9 depend from claim 1 and overcome the rejection for the same reasons.

III. Rejection of Claim 14, 17, 18 and 21 under 35 USC 103(a) Based upon Murata, Washizu and Tsai

Sections 14-17 of the Office Action rejected claims 14, 17, 18 and 21 under 35 USC 103(a) as being unpatentable over Murata US Patent 6,111,659 in view of Tsai US Patent 6,226,107 and further in view of Washizu US Patent 6,195,181. For the reasons which follow, the rejection of such claims should be withdrawn.

Claim 14 recites a method for optimizing transparency scanning which includes determining whether the scanning resolution is appropriate for scanning a transparency. Claim 14 further recites alerting a user if the scanning resolution is not appropriate for scanning a transparency. Claim 21 recites a system for optimizing transparency scanning which includes means for determining whether the scanning resolution is appropriate for scanning a transparency and means for alerting a user if the scanning resolution is not appropriate for scanning a transparency.

Neither Murata, Tsai nor Washizu, alone or in combination, disclose either a method or a system where a determination is made as to whether the scanning resolution is appropriate for scanning a transparency and where a user is alerted if the scanning resolution is not appropriate for scanning a transparency. Murata merely discloses an apparatus and method by which a scan job command file for a digital copying machine may be created or modified using a remote personal computer.

In rejecting claims 14 and 21, the Office Action mischaracterizes Murata. The Office Action asserts that Murata discloses alerting a user if the scanning resolution is not appropriate for scanning a transparency and refers to Column 10, line 57-Column 11, line 7. However,

Murata discloses nothing about alerting a user if scanning resolution is not appropriate for scanning a transparency. In contrast, Murata merely discloses that if a user enters a scanning resolution in the dialog box (on the remote personal computer) that is outside of the minimum and maximum bounds for the digital copier as defined in the read function information file (the values of which are taken from the digital copier), the user is notified. Notifying a user as to whether his or her selected scanning resolution is within the capability of a scanner is starkly different from notifying a user whether the current scanning resolution is not appropriate for scanning a transparency.

Like Murata, neither Washizu nor Tsai disclose alerting a user if the scanning resolution is not appropriate for scanning a transparency. In fact, neither reference discloses anything about alerting the user. Thus, whether such references are taken alone or are combined, the Office Action is fit to establish a prima facie case of obviousness since all of the claim limitations have not been met by such references.

Moreover, in contrast to the assertion made in the Office Action, it would not be obvious to modify Murata based upon both Washizu and Tsai. In the rejection, the Office Action asserts that:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Murata by Washizu to add determining whether a document is a transparency. The motivation for doing so would have been so that "the position of eliminating means is changed" (Column 3, line 58).

(Office Action dated March 2, 2007; page 8) (Emphasis added).

In attempting to additionally combine Tsai, the Office Action further asserts:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Murata by Tsai to add determining whether resolution is appropriate for a transparency. The motivation for doing so would have been "because transparent documents usually need higher resolution" (Column 2, lines 25-26).

(Office Action dated March 2, 2007; page 8).

However, such motivations alleged by the Office Action appear to overlook the actual teachings and context of such motivations. The whole point of Tsai is that the light source and lenses of Tsai do NOT have to be moved. Column 2, lines 22-23 of Tsai specifically states:

Therefore, all the scanner components do not need to be moved  
whether the material of the scanned document 108 is transparent or  
reflective.

Accordingly, the alleged motivation for also combining Washizu, "so that the position of the illuminating means is changed," directly contradicts the teachings of Tsai. In other words, given that Tsai utilizes two different optical paths along with a beam splitter or mirror to for the specific purpose of avoiding the need for moving its light source 102, Tsai specifically teaches away from any hypothetical combination which would require movement of the light source as does Washizu. The teachings of Washizu and Tsai are completely incompatible. Accordingly, it would not be obvious to modify Murata based upon both Washizu and Tsai. Thus, the rejection of claims 14 and 21 based upon Murata, Washizu and Tsai should be withdrawn. The rejection of claim 17 and 18, which depend from claim 14 should be withdrawn for the same reasons.

IV. Rejection of claims 15 and 22 under 35 USC 103(a) Based upon Murata, Washizu, Tsai and Ellson

Section 18 of the Office Action rejected claims 15 and 22 under 35 USC 103(a) as being unpatentable over Murata US Patent 6,111,659 in view of Tsai US Patent 6,226,107 and Washizu US Patent 6,195,181 and further in view of Ellson US Patent 5,381,526. Claims 15 and 22 depend from claims 14 and 21, respectively, and overcome rejection for the same reasons discussed above with respect to claims 14 and 21.

V. Rejection of claims 16 and 23 under 35 USC 103(a) Based upon Murata, Washizu, Tsai and Stewart

Section 19 of the Office Action rejected claims 16 and 23 under 35 USC 103(a) as being unpatentable over Murata US Patent 6,111,659 in view of Tsai US Patent 6,226,107 and Washizu US Patent 6,195,181 and further in view of Stewart et al. US Patent 5,283,671. Claims 16 and 23 depend from claims 14 and 21, respectively, and overcome rejection for the same reasons discussed above with respect to claims 14 and 21.

VI. Rejection of claims 19 and 20 under 35 USC 103(a) Based upon Murata, Washizu, Tsai and Goodman

Section 20 of the Office Action rejected claims 19 and 20 under 35 USC 103(a) as being unpatentable over Murata US Patent 6,111,659 in view of Tsai US Patent 6,226,107 and Washizu US Patent 6,195,181 and further in view of Goodman et al. US Patent 6,757,071. Claims 19 and 20 depend from claim 14 and overcome rejection for the same reasons discussed above with respect to claim 19.

Moreover, Claim 19 recites the additional step of suggesting an alternative scanning resolution where the scanning resolution is not optimized for transparency scanning.

The Office Action acknowledged that neither Murata, Washizu nor Tsai discloses the step of suggesting an alternative scanning resolution where the scanning resolution is not optimized for transparency scanning. As a result, the Office Action attempts to additionally rely upon Goodman and asserts that Goodman discloses such in Column 5, line 48-Column 6, line 3; Figure 6.

However, this is not correct. As noted in the response to the previous Office Action dated March 9, 2006, Goodman says nothing about scanning documents. Goodman says nothing about adjusting scanning resolution. Moreover, Goodman is not from the transparency field of endeavor. Rather, Goodman is limited to an intelligent printer driver. In response to such previous points made with respect to claim 14, the Office Action found Applicants' arguments to



be persuasive. (See Office Action dated September 7, 2006, pg. 2). Accordingly, the rejection of claims 19 and 20 should be withdrawn for this additional reason.

VII. Added Claims

With this response, claims 24 and 25 are added. Claims 24 and 25 depend from claims 11 and 12, respectively, and are believed to be patently distinct over the prior art to record for the same reasons discussed above with respect to claims 11 and 12, respectively.

Claims 24 and 25 further recite additional features which further patentably distinguish such claims over the prior art of record. For example, claim 24 recites means for determining whether the font sizes are optimized for transparency printing. Claim 25 recites means for determining whether the colors are optimized for scanner printing. Accordingly, claims 24 and 25 are presented for consideration and allowance.

VIII. Conclusion

Claims 1-2, 4-12 and 14-25 are now pending in this application.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers

submitted herewith, Applicants hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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